REMARKS

In the Office Action dated February 27, 2007, claims 1, 3-11, 13-16, 18-26, and 27-28 were rejected under 35 U.S.C. § 103 over Applicant's alleged Admitted Prior Art ("AAPA") in view of www.google.com (web.archive.org dated January 19, 2001) (hereinafter "Google document").

It is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to independent claim 1. *See In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (holding that the PTO has the burden under section 103 to establish a *prima facie* case of obviousness, and that this burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references).

To make a determination under § 103, several basic factual inquiries must be performed, including: (1) determining the scope and content of the prior art; and (2) ascertaining the differences between the prior art and the claims at issue. *See Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965).

In the present case, it is clear that the hypothetical combination of AAPA and the Google document clearly does not disclose or hint at the claimed subject matter. The AAPA cited by the Office Action is the Background section of the present application, which refers to the use of registries by a service to allow a service provider to register with a centralized registry so that its service can be made available to clients. Specification, page 4, lines 18-20. As conceded by the Office Action, AAPA does not disclose finding one or more prospective e-services by matching the one or more search parameters with published e-service descriptions, which are published by corresponding service provider organizations for e-services. As recited in claim 1, the finding of the one or more prospective e-services is performed by a discovery agent.

As disclosing the claim feature that is missing from AAPA, the Office Action cited the Google document. The subject matter of the Google document is quite different from the claim feature that the Office Action has conceded is missing from AAPA. Namely, the claim feature is that a discovery agent is employed to find one or more prospective e-services based on one or more search parameters, where the e-services are published by corresponding service provider organizations in respective e-service descriptions, and where finding the one or more prospective

e-services includes matching the one or more search parameters with the published e-service descriptions. The Google document discusses merely a SiteSearch or a WebSearch feature – there is no hint anywhere in the Google document of matching one or more search parameters with published e-service descriptions by service provider organizations for e-services to find one or more prospective e-services.

According to the Google document, the custom WebSearch feature provided by Google allows for Internet search "on your portal or destination site." Google Document, at 3. Moreover, the WebSearch feature "enables your site visitors to search the Internet." *Id.* "With Google, your site visitors can search over one billion pages of the Internet." *Id.* As further described on page 5 of the Google document, the WebSearch feature is a "hosted solution that allows your visitors to conduct web and specialty searches on your site, with the results provided within your own template." *Id.* at 5.

The SiteSearch feature "enables your site visitors to search just your site ...." *Id.* at 3. The SiteSearch feature is a "fully customized way for users to search just your site." *Id.* The SiteSearch feature is also a "hosted solution that allows your visitors to conduct web and specialty searches on your site ...." *Id.* at 9.

Basically, the Google document describes features provided by the Google search engine that allow a provider of a website to incorporate a search feature (either the WebSearch feature or the SiteSearch feature) onto the provider's website to allow for web searching.

Since neither AAPA nor the Google document teaches or hints at all elements of claim 1, it is respectfully submitted that the hypothetical combination of AAPA and the Google document fails to disclose or hint at the claimed subject matter. In view of the significant difference between the claimed subject matter and the prior art (in this case, the hypothetical combination of AAPA and the Google document), it is respectfully submitted that the basic factual inquiries of *Graham v. John Deere* have established that claim 1 is non-obvious over AAPA and the Google document.

Moreover, when performing an obviousness analysis, it is important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way that the claimed new invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745, 36, 82 U.S.P.Q.2d 1385 (2007). Here, there clearly did

not exist any reason to combine the teachings of AAPA and the Google document. Note that AAPA refers to the requirement that a service provider must register with centralized registries before the service provider's services can be made available to clients. As noted by the AAPA, the registration may involve a fee collected by the registry and may involve a burden on the service provider. Also, the AAPA notes that the exposure of the services to customers may be limited.

The registration requirement of the AAPA is contrasted with the subject matter of claim 1, where a discovery agent is employed to find one or more prospective e-services based on one or more search parameters, and where the e-services are published by corresponding service provider organizations in respective e-service descriptions. The publication of e-service descriptions that can be matched to one or more search parameters, as recited in claim 1, avoids the need to perform centralized registration as taught by the AAPA.

The registration requirement of the AAPA is also completely unrelated to the teachings of the Google document that allow a website provider to incorporate a search feature, either the WebSearch or SiteSearch feature, onto the provider's website to allow for web searching. There is no reason to incorporate web searching into centralized registration as described by the AAPA. Therefore, the Office Action has clearly failed to cite to any reason to combine the teachings of AAPA and the Google document to achieve the claimed invention.

In view of the foregoing, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to claim 1.

Independent claim 11 was also rejected as being obvious over AAPA and the Google document. The Office Action stated that claim 11 is similar to claim 1, and therefore rejected over similar reasons as for claim 1. 2/27/2007 Office Action at 4. However, the Office Action did not consider the difference between the subject matter of claim 11 and the subject matter of claim 1. Claim 11 specifically recites that the e-service descriptions are published at web servers of corresponding service providers, where the e-service descriptions describe respective Internet-based commercial services provided by corresponding service providers. These elements of claim 11 are not in claim 1.

The arguments presented above with respect to claim 1 apply to claim 11. Moreover, in view of the further recitation in claim 11 that e-service descriptions are published at web servers of corresponding service providers, that is a further basis to distinguish the AAPA from the subject matter of claim 11. In fact, the centralized registration requirement of the AAPA is directly at odds with the e-service descriptions that are published at web servers of corresponding service providers, recited in claim 11. Rather than centralizing registration to allow for clients to discover e-services, claim 11 allows for publication of the e-service descriptions at web servers of corresponding service providers such that one or more e-services satisfying one or more search parameters can be identified. Therefore, in view of the further difference between claim 11 and the AAPA, that is a further basis that claim 11 is non-obvious over AAPA and the Google document.

Dependent claims are allowable for at least the same reasons as corresponding independent claims.

With respect to dependent claims 5-7, the Office Action merely stated that they "deal with well-known protocol features," and therefore are "inherently included in www.google.com, pages 3, 6-7." 2/27/2007 Office Action at 3. The Office Action further stated that "the use of other well known protocol features would have been obvious as mere [sic] using other similar well known protocol features." *Id.* The latter argument in the Office Action appears to be a circular argument, basically stating that use of well known protocol features would have been obvious as using well known protocol features. No support exists for this contention. The Office Action has cited to no objective evidence that would have suggested a modification of AAPA and the Google document to achieve the subject matter of claims 5-7. The Office Action has also failed to cite to any evidence that indicates that the features of claims 5-7 are well known. More fundamentally, the Office Action has cited to no evidence that would have provided the reason to modify AAPA and the Google document to achieve the claimed invention.

With respect to claim 7, there is absolutely no hint anywhere in any of the cited references of an "e-service data sheet." In fact, the e-service data sheet is clearly not a feature that is "well known."

With respect to claims 8-10 and 21-26, the Office Action further stated that the features of those claims would also be "well known," without citing to any objective evidence that establishes a modification of the AAPA and the Google document to achieve the claimed subject matter. Therefore, the rejection of these claims is clearly defective.

With respect to claims 15 and 16, the Office Action stated that they "appear to be dealt with further limitation of the discovery agent," which are taught in the "searching engine of google.com." 2/27/2007 Office Action at 4. It is clear that the search engine of google.com does not perform a match of one or more search parameters with e-service descriptions.

The rejection of claims 18-20 and 27 and 28 are similarly defective for similar reasons as for claims 7-10 and 21.

In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10007908-1).

Respectfully submitted,

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Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
1616 South Voss Road, Suite 750
Houston, TX 77057-2631
Telephone: (713) 468-8880
Facsimile: (713) 468-8883